

**REMARKS**

At the outset, Applicant thanks the Examiner for the thorough review and consideration of the subject application. The Final Office Action of May 10, 2004 has been received and its contents carefully reviewed.

Claims 40-45 are hereby added. Accordingly, claims 1, 4, 14, 16, 20, 21, and 40-45 are currently pending.

In the Final Office Action, the Examiner rejected claims 1 and 14 under 35 U.S.C. § 102(e) as being anticipated by Mitsui et al. (U.S. Patent No. 5,559,617); rejected claims 4 and 16 under 35 U.S.C. § 103(a) as being unpatentable over Mitsui et al. in view of Arakawa (U.S. Patent No. 5,189,538); and rejected claims 20 and 21 under 35 U.S.C. § 103(a) as being unpatentable over Mitsui et al. in view of Sugiyama et al. (U.S. Patent No. 5,757,455).

The rejection of claims 1 and 14 under 35 U.S.C. § 102(e) as being anticipated by Mitsui et al. is respectfully traversed and reconsideration is requested.

Claim 1 is allowable over Mitsui et al. in that claim 1 recites a combination of elements including, for example, “two uniaxial optical compensation films... over the second substrate.” Mitsui et al. fails to teach, either expressly or inherently, at least this feature of the claimed invention.

Claim 14 is allowable over Mitsui et al. in that claim 14 recites a combination of elements including, for example, “providing two uniaxial optical compensation films... over the second substrate.” Mitsui et al. fails to teach, either expressly or inherently, at least this feature of the claimed invention.

More specifically, while the Examiner cites Mitsui et al. as allegedly teaching “two uniaxial optical compensation films (13, 14) (col. 6, lines 11-13)... over the second substrate

(3)," Applicant respectfully submits Mitsui et al. is silent with regard to whether the "compensation films (13, 14)" are uniaxial optical compensation films. For example, at column 6, lines 11-13, Mitsui et al. states "first and second optical compensation members 13 and 14 are formed on the surface of the glass substrate 3," at column 10, lines 58-63, Mitsui et al. states "the retardation of the first optical phase compensation member 13 due to the oblique evaporation was set to 130 nm. Furthermore, a stretched film made of polycarbonate was used as the second optical phase compensation member 14, and the retardation of the stretched film was set to 130 nm," and at column 12, lines 14-23, Mitsui et al. states "A stretched film made of polycarbonate was used as the first optical phase compensation member 13 of the reflective liquid crystal display device... and patterned by a dry etching technique.... Then, a stretched film made of polycarbonate and functioning as the second optical phase compensation member 14 was disposed on the member 13." Similar to the passages cited above by the Examiner, Applicant respectfully submits that the entire disclosure of Mitsui et al. lacks any express or inherent teaching that the first and second optical phase compensation members 13 and 14 of Mitsui et al. are uniaxially stretched, as asserted by the Examiner. For at least this reason, Applicant respectfully requests withdrawal of the present rejection under 35 U.S.C. § 102(e).

In the "Response to Arguments" section of the present Office Action, the Examiner asserts "polycarbonate is inherently a uniaxially oriented polymer film unless disclosed otherwise" and therefore, "the optical compensation members are inherently uniaxially stretched." The Examiner further notes Figure 6 of Mitsui et al. as showing "only one optical axis for each of the optical compensation films."

Applicant respectfully submits that directions L1 and L2 indicate the direction of the "slower optic axis of the first optical phase compensation member 13" and the "slower

optic axis of the second optical phase compensation member 14,” respectively. Therefore, Applicants respectfully submit the fact that Mitsui et al. shows “slower optic axes” of each of the optical phase compensation films, does not make it inherent that the optical phase compensation films are uniaxially oriented.

According to M.P.E.P. § 2112, inherency can only be established when extrinsic evidence makes it clear that the missing descriptive matter is necessarily present in the thing described in the reference. In relying upon the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the reference.

By asserting “[because] polycarbonate is inherently a uniaxially oriented polymer film unless disclosed otherwise the optical compensation members are inherently uniaxially stretched,” Applicant respectfully submits the Examiner has failed to provide any basis in fact and/or technical reasoning to reasonably support a determination that the optical phase compensation members of Mitsui et al. must necessarily be “uniaxially oriented.”

As noted in M.P.E.P. § 2112, the fact that a certain characteristic may be present in a reference is not sufficient to establish inherency of that characteristic. Therefore, in stating “polycarbonate is inherently a uniaxially oriented polymer film unless disclosed otherwise,” the Examiner admits that the optical phase compensation members of Mitsui et al. may not, in every instance, be uniaxially oriented. Because the optical phase compensation members of Mitsui et al. are not necessarily uniaxially oriented, Mitsui et al. fails to anticipate the present invention. For at least this reason, Applicant respectfully requests withdrawal of the present rejection under 35 U.S.C. § 102(e).

The rejection of claims 4 and 16 under 35 U.S.C. § 103(a) as being unpatentable over Mitsui et al. in view of Arakawa is respectfully traversed and reconsideration is requested.

Claims 4 and 16 include all of the limitations of claims 1 and 14, as discussed above, and Mitsui et al. fails to teach or suggest at least the features of independent claims 1 and 14 as recited above. Similarly, Arakawa fails to cure the deficiencies of Mitsui et al. Accordingly, Applicant respectfully submits that the Examiner has not established a *prima facie* case of obviousness regarding claims 4 and 16 in view of claims 1 and 14, as above.

The rejection of claims 20, and 21 under 35 U.S.C. § 103(a) as being unpatentable over Mitsui et al. in view of Sugiyama et al. is respectfully traversed and reconsideration is requested.

Claims 20 and 21 include all of the limitations of claim 14, as discussed above, and Mitsui et al. fails to teach or suggest at least the features of independent claim 14 as recited above. Similarly, Sugiyama et al. fails to cure the deficiencies of Mitsui et al. Accordingly, Applicant respectfully submits that the Examiner has not established a *prima facie* case of obviousness regarding claims 20 and 21 in view of claim 14, as above.

Claim 40 is allowable over the cited references in that the claim recites a combination of elements including, for example, “two uniaxial optical compensation films of a same type and shape over the second substrate.” Similarly, claim 42 is allowable over the cited references in that claim 42 recites a combination of elements including, for example, “providing two uniaxial optical compensation films of a same type and shape over the second substrate.” The cited references, singly or in combination, fail to teach at least these features of the claimed invention. For example, at Figure 1 and column 7, lines 15-25, Mitsui et al. teaches wherein the first optical phase compensation member 13 has a stripe-like shape and the second optical phase

Application No.: 08/936,510

Amendment dated August 10, 2004

Reply to final Office Action dated May 10, 2004

Docket No.: 8733.004.01-US

compensation member 14 has a plate shape. Accordingly, Mitsui et al. fails to teach at least the aforementioned combination of claimed elements.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

If the Examiner deems that a telephone conversation would further the prosecution of this application, the Examiner is invited to call the undersigned at (202) 496-7500.

If these papers are not considered timely filed by the Patent and Trademark Office, then a petition is hereby made under 37 C.F.R. §1.136, and any additional fees required under 37 C.F.R. §1.136 for any necessary extension of time, or any other fees required to complete the filing of this response, may be charged to Deposit Account No. 50-0911. Please credit any overpayment to deposit Account No. 50-0911. A duplicate copy of this sheet is enclosed.

Dated: August 10, 2004

Respectfully submitted,

By   
Kurt M. Eaton

Registration No.: 51,640  
MCKENNA LONG & ALDRIDGE LLP  
1900 K Street, N.W.  
Washington, DC 20006  
(202) 496-7500  
Attorney for Applicant